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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,556	04/09/1999	J. PETER KLEIN	44033-080	7605

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MCDERMOTT WILL & EMERY  
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WASHINGTON, DC 20005-3096

EXAMINER

RAYMOND, RICHARD L

ART UNIT PAPER NUMBER

1624

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

09/288,556

Applicant(s)

KLEIN ET AL.

Examiner

Richard L. Raymond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

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## DETAILED ACTION

### *Election/Restrictions*

1. Pursuant to the requirement for election of species to clarify and complete the record, applicants have elected the compound of claim 27, a compound of formula (I) wherein  $R_1$  is  $\text{CH}_3\text{CH}(\text{OH})(\text{CH}_2)_4-$ ;  $R_2$  is  $\text{CH}_3$ ; X and Y are N; and Z is  $\text{CR}_3$  where  $R_3$  is  $\text{CH}_3\text{NHCH}_2-$ . Claims 1-7, 10-27 and 29 are readable thereon. Claim 28, drawn to compounds where  $R_1$  is  $\text{CH}_3\text{N}(\text{OH})(\text{CH}_2)_4-$ , stands withdrawn from further consideration as not being readable thereon.

### *Improper Markush Rejection*

2. Claims 1-7 and 10-25 are rejected as being improper Markush claims in the definitions of the X, Y, Z and  $R_1$  variables. With respect to the X, Y and Z variables, the resulting total compounds lack a common heterocyclic ring core. With respect to the  $R_1$  variable, the resulting total compounds containing diverse substituents are structurally diverse and patentable distinct one from the others. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Diverse fields of search in the U.S classification system and in STN/CAS are also involved. Limitation of the claims to compounds where X and Y are N, Z is  $\text{C}(\text{R}_3)$  and  $R_1$  is (hydroxy or substituted hydroxy)  $\text{C}_{(5-9)}$ -alkyl, encompassing the elected species, will overcome this rejection.

3. The rejections in the Office action of September 16, 2002 are repeated herein.

***Claim Rejections - 35 USC § 112***

4. Claims 1-7 and 10-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (1) In claim 1, the proviso clause refers to R<sub>1</sub> not being a w-1 alcohol substituted C<sub>(1-8)</sub> alkyl group, however, R<sub>1</sub> is defined as being C<sub>(5-9)</sub> hydroxyalkyl groups. See page 7, lines 10 and 11 of the specification, where alcohols of C<sub>(5-8)</sub> are provisoed. (2) In claim 1, lines 1 and 2, the reference to enantiomers, tautomers, salts and solvates should preferably be recited at the end of the claim and not contain the language “including”. (3) Claim 9, which refers to the compounds in Table 1 of the specification, is indefinite because claims should be complete in themselves. Correction and/or clarification of the above are requested.

***Claim Rejections - 35 USC § 103***

5. Claims 1-7, 10-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinze et al., of record. Specifically, the proviso in claim 1 excludes R<sub>1</sub> being an (w-1) alcohol substituted C<sub>(1-8)</sub> alkyl group when R<sub>3</sub> is H or C<sub>1-3</sub> alkyl. However, the present R<sub>1</sub> containing compounds include the simple alkyl homologs and position isomers of these prior art compounds. Further, when the present compounds when R<sub>3</sub> is 4-8 alkyl are simple homologs of the provisoed compounds. One would be motivated to prepare simple homologs and/or isomer of the reference compounds with the reasonable expectation of obtaining additional compounds for the uses in of the reference compounds. In the absence of a showing of unexpected properties, no patentable significance is seen in the present selection.

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***Conclusion***

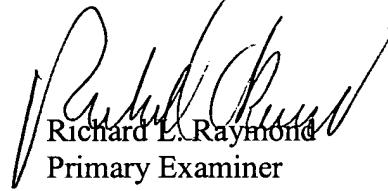
6. This action is **not** made final.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Richard L. Raymond  
Primary Examiner  
Art Unit 1624

rr  
July 25, 2003

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